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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,803	12/19/2000	Gary R. McLuen	NEI-00104	7285
28960 7590 06/09/2009 HAVERSTOCK & OWENS LLP 162 N WOLFE ROAD SUNNYVALE, CA 94086				
EXAMINER				
HANDY, DWAYNE K				
ART UNIT		PAPER NUMBER		
1797				
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06/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/742,803

**Applicant(s)**

MCLUEN ET AL.

**Examiner**

DWAYNE K. HANDY

**Art Unit**

1797

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-30, 35-38, 40, 42, 44-48 and 50-60 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 27-30, 35-38, 40, 42, 44-48 and 50-60 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/3508)  
Paper No(s)/Mail Date 02/25/09  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-29, 35-38, 40, 42, 44 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by McGraw et al. (5,368,823).

3. Claims 27-29, 35, 36, 38, 45-48, 50-54, 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuckerman et al. (5,240,680).

These rejections were maintained in the previous Office Action (mailed 12/05/08). They remain in effect. Please see Response to Arguments below.

4. Claims 27-30, 35, 36, 38, 45-48 and 50-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Cargill et al. (5,609,826). This rejection was maintained in the previous Office Action for claims 27-30, 35, 36, 38, 45-48 and 50-58. It now includes new claims 59-60. Please see Response to Arguments below.

***Response to Arguments***

5. Applicant's arguments filed 03/05/09 have been fully considered but they are not persuasive. Applicant has argued that McGraw fails to anticipate the instant claims

because McGraw does not show teach a direct fit between the vial (column) and cartridge (bulkhead). See Applicant's Arguments, pages 9-15. This argument is beyond the scope of the claims as written. As noted in the previous Office Action (paragraph 6); the vial of McGraw still meets this limitation (as do the vials of Zuckermann and Cargill). The claim as currently written does not include the hole of the cartridge or even the cartridge. Applicant has not claimed the cartridge. Applicant has claimed a "having an exterior dimension to fit directly within a receiving hole of a cartridge". Therefore, any vial that has an exterior dimension that allows it to fit directly in a hole will meet this limitation. Applicant is attempting to limit an element of the claimed device - an exterior dimension of the vial - by using another, unclaimed element - a cartridge hole. The Examiner submits that there is no structural limitation that is provided by this phrase. The vials/vessels of the prior art have a dimension that would allow them to fit directly into the receiving hole of a cartridge in a pressure tight seal. Therefore the vials of the references meet that limitation.

6. Applicant has argued that Zuckermann does not teach a solid support or the pressure tight seal (Applicant's arguments, pages 15-23). As noted above, the pressure tight seal is beyond the scope of the claim. The claim merely requires that the vial have an exterior dimension to fit directly in a receiving hole. This is what Zuckermann shows in Figure 3. The Examiner previously noted (See Paragraph 7 of the previous Action; Paragraph 6 of the Office Action mailed 12/12/07 and Paragraph 8 of the 3/21/07

Action) that Zuckermann does not show the solid support but their use is disclosed in columns 2 and 3.

7. Applicant has argued (Arguments, pages 23-31) that Cargill does not teach a solid support or the pressure tight seal. As noted above, the pressure tight seal is beyond the scope of the claim. The claim merely requires that the vial have an exterior dimension to fit directly in a receiving hole. This is what Cargill shows in Figures 6-8. The Examiner previously noted (See Paragraph 8 of the previous Action; Paragraph 7 of the Office Action mailed 12/12/07 and Paragraph 9 of the 3/21/07 Action) that Cargill does not show the solid support but their use is disclosed in column 2 and at the end of column 7.

8. Applicant has also argued that because McGraw recites the use of a vacuum to draw the chemical through the column (McGraw, col. 2, lines 17-22), then this excludes the presence of a pressure tight seal (Applicant's Arguments, page 11). The Examiner respectfully disagrees and notes that McGraw is not using the vacuum to seal the vial to the bulkhead, but instead is simply using vacuum to empty the contents of the columns into the exit basin (17). Furthermore, the Examiner submits that if there wasn't a pressure tight fit between McGraw's vial and the opening (15) in the bulkhead (16), then the vacuum could not function to draw the chemicals through the columns to the exit basin (17).

9. Applicant has argued that the Examiner has either unilaterally dismissed the pressure tight seal limitation or not given it proper weight (Arguments, page 11; page 16; and page 24). This is not the case. The Examiner has stated that the Applicant's arguments directed to the limitation of "an exterior dimension to fit directly within a receiving hole of a cartridge" are beyond the scope of the claim as written. This limitation is based upon an element – the receiving hole of the cartridge – which is not part of the claimed device. Therefore, the limitation of the "exterior dimension to fit directly within a receiving hole of a cartridge" is extremely broad. The dimension could be any shape or size - as long as the element is capable of fitting in a hole of a cartridge, it will meet this claim. Applicant has argued that the references do not show a vial placed directly into a cartridge; therefore, the vials do not meet this limitation. This is incorrect and the reason for Examiner's assertion that the argument is beyond the scope of the claim. For this particular limitation, the reference does not have to show the vial directly in a cartridge; it simply has to show a vial having "an exterior dimension to fit directly within a receiving hole of a cartridge". The Examiner submits that the lower portion of the vials in each of the references cited show just this feature – a round portion that could fit directly into a cartridge hole. See Figures 5 and 6 of McGraw, Figures 2 and 3 of Zuckermann, and Figure 2A of Cargill.

10. Applicant has also argued that Cargill does not teach polyethylene vial (Page 24 of Arguments). The Examiner directs Applicant to column 7, lines 36-44 of Cargill for a teaching of the use of polyethylene for the reaction vessel.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 11:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne K Handy/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797  
June 7, 2009